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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,199	12/15/2000	Daniel C. Castle	10002991-1	1135

7590 05/30/2006

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER
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RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/738,199

Applicant(s)

CASTLE ET AL.

Examiner

Yehdega Retta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19,21,23-30,32 and 35-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19,21,23-30,32 and 35-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response to amendment filed January 22, 2004. Applicant amended claims 1, 10, 13, 27, 36 and 37. Claims 20, 22, 23, 31, 33 and 34 have been cancelled. Currently claims 1-19, 21, 23-30, 32 and 35-37 are pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites offer to place advertisement on a page in said on-line publication, further recites, "placing on the page said on-line publication, the advertisement". It is not clear whether the publication is place on the page or the advertisement. The page is part of the publication. Appropriate correction is required. Examiner interpreted the claim feature as placing the advertisement on the page of the publication.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson et al. (US 5,974,398) further in view of Mason et al. (US 6,401,075).

Regarding claims 1, 4, 6-9, 13-19, 21, 24-30, 32 and 35 Hanson teaches obtaining offers to place advertisement on a page in an on-line publication; selecting the greatest offer; identifying at least one subscriber to which the page of the on-line publication, according to demographic data; placing on the page of the on-line publication the advertisement; wherein the offers are for a determinable sum (see fig. 13-15, col. 9 line 29 to col. 11 line 5); determining whether an advertisement selected for publication has been previously placed; selecting content information based upon subscriber demographic data (see col. 8 line 63 to col. 9 line 23). Hanson does not disclose automatically resizing content and the advertisement to fit within available space on the page in publication space. Mason teaches an original advertisement being automatically reconfigured for placement on hundreds of online newspaper. It would have been obvious to one of ordinary skill in the art at the time of the invention to resize the advertisement of Hanson by automatically reconfiguring, as in Mason, it to fit in the publication of Hanson (see col. 5 line 4 to col. 6 line 6).

Regarding claims 2-3 and 5, Hanson teaches publication distributed for publication using the Internet, wherein the publication is comprised of information obtained from a plurality of sources (see col. 9 line 62 to col. 10 line 6, col. 11 line 57 to col. 12 line 27).

Regarding claim 36, Hanson teaches a computer identifying advertisement that comport with the subscriber profile; data storage where the profile information is stored; an interface enabling the exchange of data between advertisers and first computer and between subscribers to

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said publication and first computer (see fig. 1 & fig. 13-15, col. 9 line 29 to col. 11 line 5).

Hanson teaches placing an advertisement corresponding to an advertiser with a greatest price in a publication space. Hanson does not disclose resize module for automatically resizing content and the advertisement to fit within available space on the page in publication space. Mason teaches an original advertisement being automatically reconfigured for placement on hundreds of online newspaper. It would have been obvious to one of ordinary skill in the art at the time of the invention to resize the advertisement of Hanson by automatically reconfiguring, as in Mason, it to fit in the publication of Hanson (see col. 5 line 4 to col. 6 line 6).

Claim 37 is rejected as stated above in claim 1.

Claims 10-12, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mason et al. (US 6,401,075) further in view of Hanson et al. (US 5,974,398).

Regarding claims 10-12, Mason teaches receiving a publication into which advertising material as an advertisement to be placed for publication using a predetermined methodology; automatically resizing the advertisement corresponding to an advertiser to fit within a publication space on the page and automatically resizing at least one of the existing content to fit within available space on the page (see col. 5 line 4 to col. 6 line 36). Manson teaches the advertiser pay for placing the ad (see col. 6 lines 8-26) however failed to explicitly teach that the advertisement with greatest price is placed. Hanson teach the advertisement with the highest bid price selected for placement in a publication. It would have been obvious to one of ordinary skill in the art at the time of the invention to select the ads of Manson based on the price as in Hanson to maximize the revenue of the service provider.

***Response to Arguments***

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Applicant's arguments with respect to claims 1-19, 21, 23-30, 32 and 35-37 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Eldering (US 6,324,519) teaches displaying ads based on the highest bid price to subscriber with the corresponding demographic data.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YR

  
RETTA YEHDEGA  
PRIMARY EXAMINER